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Attorney Docket No: 33332-71679

AF 13711

22 Reply Brief
for mega-
11/13/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Srikanth RAO Confirmation No. 3965
Serial No.: 09/845,643 Art Unit: 3711
Filed: April 30, 2001 Examiner: Steven B. Wong
For: A GOLF BALL MARKER AND HOLDER

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Honorable Commissioner for
Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

Call to Mr. Wong
This is a reply brief in support of an appeal taken from the Final Rejection of claims 1, 3-7, 9-10 and 13-18, mailed May 14, 2003. A notice of appeal and the appeal brief were filed June 23, 2003. The examiner's answer was mailed October 28, 2003.

At page 4 of the examiner's answer it is stated "[r]egarding the limitation of claim 18 for the golf tool to be sized for attachment to a shoe, as stated above because the tool is capable of being attached to a shoe it is obviously shaped for attachment to a shoe." The golf ball marker of claim 18 requires the clip to be both sized and shaped for attachment to a shoe. Appellant's specification at, for example, paragraph 10 discussed "a clip 12 that is sized for attachment to a shoe 11, and at, for example, paragraph 11 there is reference to a particular shape to "reduce the likelihood of discomfort to the golfer...." Thus, both size and shape are limitations and the allegation that Giglio's accessory is capable does not teach or suggest these claimed limitations.

The examiner's answer at page 7 asserts, in part, that "it should be noted that the means plus function language of claim 17 relates to the means for fixing a ball marker to the outer portion and nothing else." This statement is incorrect since claim 17 last line recites "means for releasably fixing a ball marker to the outer portion." The term "releasably" describes structure and function described in the specification and shown in the drawing at, for example, page 3, paragraph 11 and Figs 2 and 3. The prior art Giglio reference does not teach or suggest a ball marker holder as recited in claim 17 including the means for releasably fixing a ball marker to the outer portion.

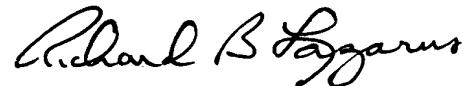
Conclusion of Argument

For all of the reasons in appellant's brief and the above additional reasons, the rejection of claims 1, 3-7, 9-10 and 13-18 is improper and should be reversed.

Appellant, respectfully, requests reversal of the rejections.

Respectfully submitted,

BARNES & THORNBURG



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